



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,742	06/19/2000	J.Carr Bettis	26119.100 US1	3881

24395 7590 08/13/2003

HALE & DORR LLP
THE WILLARD OFFICE BUILDING
1455 PENNSYLVANIA AVE, NW
WASHINGTON, DC 20004

EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/597,742

Applicant(s)

BETTIS ET AL.

Examiner

Narayanswamy Subramanian

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-130 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-130 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3, 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-20, 127 and 129, drawn to a method and system of evaluating an investor's performance by utilizing information pertaining to at least one transaction made by the investor involving at least one investment, comprising the steps of determining a performance score indicative of the investor's performance relative to other investors, said performance score determined at least in part by considering an average historical performance of the at least one investment following the at least one transaction, a historical consistency of the investor's performances with respect to transactions involving the at least one investment, and the number of transactions made by the investor and comparing the performance score of the investor against performance scores of other investors, classified in class 705, subclass 36.

II. Claims 21-39, 128, 130, drawn to a method and system for use in producing a ranked list of investors according to an evaluation of the investors' performances relating to at least one transaction made by the investors involving investments associated with the investors, comprising the steps of retrieving a list of investors, generating an evaluation list by removing investors failing to meet predetermined criteria from said list, calculating a performance score for each investor listed on said evaluation list indicative of the investor's performance by considering an average historical performance of an investment following a transaction by the investor, a historical consistency of the investor's performances with respect to transactions involving the at least one investment, and the number of transactions made by the investor and calculating, for each investor using said performance scores, a final transaction score indicative of the investor's

Art Unit: 3624

relative performance with respect to all investors on said evaluation list, classified in class 705, subclass 36.

III. Claims 40-59, drawn to a system for evaluating an investor's performance by utilizing information pertaining to at least one transaction made by the investor involving at least one investment, comprising a processor, a memory storing a computer program controlling operation of said processor, said program including instructions for causing the processor to effect, determining a performance score indicative of the investor's performance relative to other investors, said performance score determined at least in part by considering an average historical performance of the at least one investment following the at least one transaction, a historical consistency of the investor's performances with respect to transactions involving the at least one investment, and the number of transactions made by the investor and comparing the performance score of the investor against performance scores of other investors, classified in class 705, subclass 36.

IV. Claims 60-78, drawn to a system for use in producing a ranked list of investors according to an evaluation of the investors' performances relating to at least one transaction made by the investors involving investments associated with the investors, comprising a processor, a memory storing a computer program controlling operation of said processor, said program including instructions for causing the processor to effect retrieving a list of investors, generating an evaluation list by removing investors failing to meet predetermined criteria from said list, calculating a performance score for each investor listed on said evaluation list indicative of the investor's performance by considering an average historical performance of an investment following a transaction by the investor, a historical consistency of the investor's

Art Unit: 3624

performances with respect to transactions involving the at least one investment, and the number of transactions made by the investor and calculating, for each investor using said performance scores, a final transaction score indicative of the investor's relative performance with respect to all investors on said evaluation list, classified in class 705, subclass 36.

V. Claims 79-98, drawn to a computer readable medium storing instructions executable by a computer, the instructions instructing the computer to effect evaluating an investor's performance by utilizing information pertaining to at least one transaction made by the investor involving at least one investment, said instructions comprising determining a performance score indicative of the investor's performance relative to other investors, said performance score determined at least in part by considering an average historical performance of the at least one investment following the at least one transaction, a historical consistency of the investor's performances with respect to transactions involving the at least one investment, and the number of transactions made by the investor and comparing the performance score of the investor against performance scores of other investors, classified in class 705, subclass 36.

VI. Claims 99-117, drawn to a computer readable medium storing instructions executable by a computer, the instructions instructing the computer to effect producing a ranked list of investors according to an evaluation of the investors' performances relating to at least one transaction made by the investors involving investments associated with the investors, said instructions comprising retrieving a list of investors, generating an evaluation list by removing investors failing to meet predetermined criteria from said list, calculating a performance score for each investor listed on said evaluation list indicative of the investor's performance by considering an average historical performance of an investment following a

Art Unit: 3624

transaction by the investor, a historical consistency of the investor's performances with respect to transactions involving the at least one investment, and the number of transactions made by the investor; and calculating, for each investor using said performance scores, a final transaction score indicative of the investor's relative performance with respect to all investors on said evaluation list, classified in class 705, subclass 36.

VII. Claims 118-120, drawn to a method for evaluating an investor's performance by utilizing information pertaining to at least one transaction made by the investor involving at least one investment, comprising determining a probability that a predetermined investor's return will occur; generating a conditional performance measure indicative of the investor's performance by utilizing said probability, adjusting the conditional performance measure utilizing at least one factor relating to and further characterizing the investor's performance to result in a final performance score and ranking the investor using the performance score relative to other investors, classified in class 705, subclass 36.

VIII. Claims 121-16, drawn to an interactive computer-implemented interface for displaying a listing of investors ranked according to a performance order by utilizing information pertaining to at least one transaction made by each investor involving at least one investment, said interactive interface comprising a computer-driven display, a listing of investors displayed on said computer-driven display ranked by utilizing at least one of an average historical performance of the at least one investment following the at least one transaction, a historical consistency of the investor's performances with respect to transactions involving the at least one investment, and a number of transactions made by the investor, said listing providing names used to identify the investors, and a performance score used to rank the investors and a sporting event

Art Unit: 3624

scoreboard including a template displayed on said computer driven display and incorporating said listing of investors ranked according to the performance order, facilitating a user's review of said listing, classified in class 705, subclass 36.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to a method and system of evaluating an investor's performance by utilizing information pertaining to at least one transaction made by the investor involving at least one investment, comprising the steps of determining a performance score indicative of the investor's performance relative to other investors, said performance score determined at least in part by considering an average historical performance of the at least one investment following the at least one transaction, a historical consistency of the investor's performances with respect to transactions involving the at least one investment, and the number of transactions made by the investor and comparing the performance score of the investor against performance scores of other investors, whereas invention II relates to a method and system for use in producing a ranked list of investors according to an evaluation of the investors' performances relating to at least one transaction made by the investors involving investments associated with the investors, comprising the steps of retrieving a list of investors, generating an evaluation list by removing investors failing to meet predetermined criteria from said list, calculating a performance score for each investor listed on said evaluation list indicative of the investor's performance by considering an average historical performance of an investment following a transaction by the investor, a historical consistency of the investor's performances

Art Unit: 3624

with respect to transactions involving the at least one investment, and the number of transactions made by the investor and calculating, for each investor using said performance scores, a final transaction score indicative of the investor's relative performance with respect to all investors on said evaluation list. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Inventions I and III are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to a method and system of evaluating an investor's performance by utilizing information pertaining to at least one transaction made by the investor involving at least one investment, comprising the steps of determining a performance score indicative of the investor's performance relative to other investors, said performance score determined at least in part by considering an average historical performance of the at least one investment following the at least one transaction, a historical consistency of the investor's performances with respect to transactions involving the at least one investment, and the number of transactions made by the investor and comparing the performance score of the investor against performance scores of other investors, whereas invention III relates to a system for evaluating an investor's performance by utilizing information pertaining to at least one transaction made by the investor involving at least one investment, comprising a processor, a memory storing a computer program controlling operation of said processor, said program including instructions for causing the processor to effect, determining a performance score indicative of the investor's performance relative to other investors, said performance score determined at least in part by considering an

Art Unit: 3624

average historical performance of the at least one investment following the at least one transaction, a historical consistency of the investor's performances with respect to transactions involving the at least one investment, and the number of transactions made by the investor and comparing the performance score of the investor against performance scores of other investors. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group III, restriction for examination purposes as indicated is proper.

Inventions I and IV are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I relates to a method and system of evaluating an investor's performance by utilizing information pertaining to at least one transaction made by the investor involving at least one investment, comprising the steps of determining a performance score indicative of the investor's performance relative to other investors, said performance score determined at least in part by considering an average historical performance of the at least one investment following the at least one transaction, a historical consistency of the investor's performances with respect to transactions involving the at least one investment, and the number of transactions made by the investor and comparing the performance score of the investor against performance scores of other investors, whereas invention IV relates to a system for use in producing a ranked list of investors according to an evaluation of the investors' performances relating to at least one transaction made by the investors involving investments associated with the investors, comprising a processor, a memory storing a computer program controlling operation of said processor, said program including instructions for causing the processor to

Art Unit: 3624

effect retrieving a list of investors, generating an evaluation list by removing investors failing to meet predetermined criteria from said list, calculating a performance score for each investor listed on said evaluation list indicative of the investor's performance by considering an average historical performance of an investment following a transaction by the investor, a historical consistency of the investor's performances with respect to transactions involving the at least one investment, and the number of transactions made by the investor and calculating, for each investor using said performance scores, a final transaction score indicative of the investor's relative performance with respect to all investors on said evaluation list. See MPEP § 806.05(d). Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group IV, restriction for examination purposes as indicated is proper.

Similarly other pairing of inventions stated above are related as sub combinations disclosed as usable together in a single combination. These inventions are distinct from each other as can be evident from the definition of the groups described above. Also they require separate searches and hence restriction of these inventions for examination purposes as indicated is proper.

3. A telephone call was made to Mr. Irah H. Donner on July 8, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

4. Applicants are advised that reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is

Art Unit: 3624

(703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian
July 11, 2003

Richard Weisberger
Primary Examiner